UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,634	03/03/2006	Ken Shoji	TAK-18150	2950

7609 7590 05/22/2009

RANKIN, HILL & CLARK LLP
925 EUCLID AVENUE, SUITE 700
CLEVELAND, OH 44115-1405

EXAMINER	
GRESO, AARON J	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
05/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/570,634	SHOJI ET AL.	
	Examiner	Art Unit	
	AARON GRESO	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-35* is/are pending in the application.

4a) Of the above claim(s) *30,31,34 and 35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-29, 32-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *05/01/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Any rejections and/or objections made in the previous Office Action and not repeated below, are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Newly submitted Claims 30-31 and 34-35 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: The inventions of Claims 30-31 and 34-35 now include using an acquired basis comparison elements and test subject assessments, while additionally providing for a selection of a perfume, respectively.

Methods in the art can be regarded as applying innate olfactory ability to make an assessment, but not necessarily requiring an assessment, after smelling an ingredient. It is also common to describe the aroma sensed (e.g., reporting a note in some manner) without either: requiring an olfactory assessment of a plurality of subjects to determine a correlation involving images to determine a basis that can include subsequent evaluations (as in the cases of instant Claims 30-31) that include an evaluation of a test subject (as in the cases of instant Claims 34-35).

Referring to the New Claim/Old Claim chart provided by the Applicants (page 5 of 10 submitted 03/20/2009: Pre-amended Claims 1+2+4, and 16 for instant Claim 16 and

pre-amended Claims 1+3+4 and 17 for instant Claim 35, do not include test subject assessment elements involving correlations based upon test subject assessments.

Testing methods requiring subject assessments, as indicated in Claims 30-31 and 34-35, are classified in USPTO class 702, subclass 81 or class 702, subclass 182.

The other inventions, for Claims 24-29 and 32-33 concern compositions that can be innately sampled to determine a temperature-related effect that do not require presentation results or correlations These would be classified in Class 512, subclass 1 which includes compositions and processes of using.

The inventions would be expected to be related as: combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because perfume and method for controlling the sensation experienced for instant Claims 24-29, 30-31, does not require correlations for a basis and the assessment of a test subject. The subcombination of Claims 30-31 and 34-35 have separate utilities such as providing data to evaluate the reliability of the test subject, relative to the assessment of a plurality of test subjects to form a basis, and of and making a selection based upon an

assessment basis of using the perfume and a selection being made based upon correlations of assessment.

{The inventions of instant Claims 30-31 and 34-35 also include separate subcombinations; the invention elements of instant Claims 30-31 do not require a selection.}

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 30-31 and 34-35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

Claims 25, 27 are rejected under 35 U.S.C 102(b) as being anticipated by *Wiegand et al. (US App. 2002/0151527). Wiegand et al. (Tenth paragraph of Detailed Description of Preferred Embodiments)* discloses a method that uses olfactory sensory experiences with relaxing fragrances. Such a method is shown to reduce stress to enable sebum reduction *(see Table 10 along with the immediately previous and subsequent paragraphs); Wiegand et al.* directs the reader to *Librizzi et al. (US Application 09/676876 parenting 10/218774 now US 2003/0064120)* to the fragrances "incorporated by reference" in *Wiegand et al.'s* disclosure *(US App. 2002/0151527).*

The fragrance compositions disclosed by *Librizzi et al. (US Application 09/676876 parenting 10/218774 now US 2003/0064120 Claims 6-7 and Eighth paragraph, "Detailed Description of the Invention")* include chamomile and sandalwood that are also referenced by the Applicants as providing a cooling effect *(Instant Application, Eighth paragraph, "Best Mode for Carrying Out the Invention")*. The cooling properties of the chamomile and sandalwood fragrances are inherent to the reference used for controlling sensory experiences.

Claim Rejections - 35 USC § 103

Claims 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shiroyama et al. (US 6328982)* in further view of *Holt et al. (US 6348501).*

Shiroyama et al. (col 7 lines 23-65) disclose perfume compositions, provided in a controlled manner, to produce a controlled cooling effect subjectively determined by at least one person. The cool feeling composition can be used in various products, including cosmetics and colognes *(col 4 lines18-30)* to impart a cooling effect. A composition disclosed by *Shiroyama et al. (col 9 lines 26-67)* can also contain a warm feeling component.

The reference also discloses perfume compositions providing temperature sensations in a controlled manner to users and evaluators for subsequent analysis to determine compositional temperature effects for compositions *(Fig. 5 sheet 3 of 6).* Images, or charts, are shown by *Shiroyama et al. (Figures 1-9)* using cooling sensation data acquired from testing and using the compositions by skilled panelists *(e.g., col 3*

lines 20-23 and Examples 1-5 col.s 5-8) to aid in assessment. Because the formulations are made prior to evaluation *(e.g., Example 1 col 5 lines 24-37)*, the results indicate that changing the composition controls the temperature response.

The reference also teaches that the compositions can contain other cooling or warming agents other than those cited within the reference *(col 4 lines 12-18)*.

The reference does not further provide or demonstrate other examples of the other ingredients for producing warming sensation compositions.

On the other hand, *Holt et al. (col 5 lines 41-67 {Example 1} and Col 6 Lines 1-34 {Example 2})* teach of formulating compositions that produce a warm sensation to a user's skin. The compositions include lavender oil or lavender extract.

It would have been obvious at the time of the invention to have used equivalent materials for equivalent applications by using other warming materials, as suggested by *Shiroyama et al.*, and lavender oil, as taught by *Holt et al.*, to yield predictable results.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Shiroyama et al. (US 6328982)* as applied to Claim 24 above in view of *Holt et al. (US 6348501)* and further in view of *McCarthy (US 4603030)*.

Although experiencing the olfactory effect of a fragrance material must occur within a given area or space, neither *Shiroyama et al.* nor *Holt et al.* explicitly demonstrate the use of a fragrance composition within a specifically defined space.

On the other hand, *McCarthy (col 3 lines 37-61 and Figures 1 and 2)* teaches the use of sensation initiating fragrances for use in theater spaces called units.

It would have been obvious at the time of the invention to have applied the teachings of *Shiroyama et al.,* concerning sensation inducing materials, within the space suggested by *McCarthy* that employs sensation initiating fragrances to yield predictable results.

Claims 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Wiegand et al. (US App. 2002/0151527)* as applied to Claims 25 and 27 in view of *McCarthy (US 4603030).*

Although experiencing the olfactory effect of a fragrance material must occur within a given area or space, *Wiegand et al. (US App. 2002/0151527)* does not explicitly demonstrate the use of a fragrance composition within a specifically defined space.

On the other hand, *McCarthy (col 3 lines 37-61 and Figures 1 and 2)* teaches a controlled method for providing "one or more desired scents" into certain theater seat spaces referred to as "units".

It would have been obvious to modify the sensation fragrance teachings, disclosed by *Wiegand et al. (US App. 2002/0151527)* in conjunction with *McCarthy's* method of providing desired scents, in theater units, to yield predictable results.

Response to Arguments/Amendments

Applicant's arguments with respect to claims 1-23 have been considered but are moot as suggested by the Applicant due to cancellation and replacement of Claims 1-23

with new Claims 24-35. In addition, however, new ground(s) of rejection apply due to Claim cancellations/amendments that combine dependent claim elements from now-cancelled Claims 1-23.

Examiner Note:

Clarification, as requested by Applicant, follows:

In regard to Claim Rejections 103(a): *Shiroyama/McCarthy; Shiroyama/Nerushai*

Office Action Examiner typing error included "13-14" as included in Shiroyama in the rejections toward Claims 9 and 20-23 of *Shiroyama/McCarthy* and Claims 10-11 of *Shiroyama/Nerushai*. As correctly indicated by the applicant, "13-14" are not appropriately used in these areas. However, Rejections, based upon the correct, previously rejections referenced to art by *Shiroyama (involving only Claims 1-8 and 16-19 as indicated at the beginning paragraph of the 102 (b) rejections regarding Shiroyama art)* would have still applied had no cancelling of Claims nor adding new Claims been exercised.

Conclusion

Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

AJG